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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,770	10/30/2001	Klaus A. Wieder	1078.007	3922
23598	7590	10/08/2003	EXAMINER	
BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.			LUK, EMMANUEL S	
250 E. WISCONSIN AVENUE			ART UNIT	
SUITE 1030			PAPER NUMBER	
MILWAUKEE, WI 53202			1722	

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/021,770	WIEDER, KLAUS A.	
	Examiner	Art Unit	
	Emmanuel S. Luk	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-73 is/are pending in the application.
- 4a) Of the above claim(s) 71-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 51-70, drawn to an ejector pin for a mold, classified in class 425, subclass 577.
 - II. Claims 71-73, drawn to a method of making an ejector, classified in class 264, subclass 334.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as not hardening the blank.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with David Stein on 9/15/03 a provisional election was made without traverse to prosecute the invention of Group I, claims 51-70. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 71-73 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 51, 53-56 and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Uratani (5788872).

Uratani teaches the claimed ejector pin having a head (5) disposed at the end of a barrel (3), an indicia imprinted insert (41) is located in a cup (31) at the end of the barrel opposite the end with the head. The head can also be threadably received (33) in the barrel (Fig. 5).

The length of the barrel is "capable" of being cut, in as much as anything is capable of being cut to be short.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 52 and 57-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uratani (5788872) in view of Wagner et al (4684101).

Additionally, Uratani teaches a plurality of notches on a side wall (10) and coupling ring (9) with a pair of radial extending circumferentially spaced apart projections (91,92) and an upraised sidewall (6,10). The sidewall having a projection (102) that extends into a groove (32,34) of the barrel (3).

Uratani fails to teach the soft and hardened portions and the head having two arms with fastener and the coupling ring having a projection that extends into the barrel of the groove.

Wagner teaches two separate elements, a head (136; pin) and a barrel (130). The head is fastened to the end of the barrel via two arms (118). A fastener is located at the end of the head (124) to secure the head. The shape of the arms secures the barrel to the head, additionally, multiple arms (168,172) clamps the barrel. The pin itself acts as fasteners between the arms for clamping. It would have been obvious to one of ordinary skill in the art to modify Uratani with arms as taught by Wagner because it allows for the head to be fastened to the barrel.

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In regards to the soft and hardened portions, the hardness of a material may vary depending on the processing techniques of the material during construction. The soft portion of the barrel so it can be cut during the process of making the apparatus and does not limit the structural limitation of the apparatus.

In regards to claims 58-63, Uratani teaches the structural elements claimed except that the locator projection on the coupling ring does not enter a groove on the barrel and instead the sidewall has the projection. It would have been obvious to one of ordinary skill in the art to modify Uratani with the projection to be placed on the coupling ring because it would help prevent the sidewall from rotation.

10. Claims 65-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uratani (5788872) in view of Schroder (DE 19701025 A1), Kuhling (4708314) and Wagner (4684101).

Uratani teaches the claimed ejector pin having a head (5) disposed at the end of a barrel (3), an indicia imprinted insert (41) is located in a cup (31) at the end of the barrel opposite the end with the head. The head can also be threadably received (33) in the barrel (Fig. 5).

The length of the barrel is "capable" of being cut, in as much as anything is capable of being cut to be short.

Uratani fails to teach welding, fastener, a pocket in the head and locator flats.

In regards to welding, this is making the elements integral via the welds. It would have been obvious to one of ordinary skill in the art to modify Uratani with welding the

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head to the barrel because it is making the elements integral and is a choice of design.

In re Larson et al, 144 USPQ 347. Additionally, Schroder teaches a barrel (11) having a head (54), a welding (55) at the point between the barrel and head to prevent rotation.

It would have been obvious to one of ordinary skill in the art to modify Uratani with the welding as taught by Schroder because it seals the head with the barrel.

In regards to the locator flat and fastener, Kuhling teaches an apparatus having a barrel (19) and head (26) located at one end of the barrel. To prevent rotation, the barrel having a locator flat and the barrel also having a complementary flat (31), while a spacing member acts as a fastener (30) is located in between.

It would have been obvious to one of ordinary skill in the art to modify Uratani with a locator flats and fasteners as taught by Kuhling because it would prevent the rotation between the barrel and head.

The concept of the barrel entering mounted into the pocket of a head is shown by Wagner et al where a piece (140) enters a pocket (132) formed by the barrel (130). Any rotation by either element would be prevented due to the shape of the pocket. It would have been obvious to one of ordinary skill in the art to modify Uratani with a pocket as taught by Wagner et al because it would fasten the head to the barrel and prevent rotation.

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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel S. Luk whose telephone number is (703) 305-1558. The examiner can normally be reached on Monday through Friday 8 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

E.L.


W. L. WALKER
SUPERVISORY PATENT EXAMINER
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